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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,622	02/14/2001	Frederik Ekkel	000117	2720
24738	7590	01/26/2005	EXAMINER	
PHILIPS ELECTRONICS NORTH AMERICA CORPORATION INTELLECTUAL PROPERTY & STANDARDS 1109 MCKAY DRIVE, M/S-41SJ SAN JOSE, CA 95131			KANG, PAUL H	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N

09/784,622

Applicant(s)

EKKEK, FREDERIK

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. MPEP § 719.05.

Information Disclosure Statement

2. The information disclosure statement filed September 3, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. ***Claim(s) 1-11 & 13-18 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Ferber et al. (US Patent Application Publication No. 2002/0004746 and Ferber hereinafter).***

6. As per claim(s) 1 Ferber discloses a transit terminal, providing access over an information network to a repository hosting the information content; at the transit terminal, enabling to transfer the information content over the network from the repository to a mobile storage medium; and providing use

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of the information content from the storage medium to the individual in the communication-restricted environment (See Paragraph 0009-0011).

7. As per claim(s) 2 Ferber teaches the claimed invention as described in claim(s) 1 above and furthermore discloses downloading the information content from the repository onto the mobile storage medium, (See Paragraph 0023).

8. As per claim(s) 3 Ferber teaches the claimed invention as described in claim(s) 1-2 above and furthermore discloses providing an apparatus at the transit terminal to allow the individual to cause the transfer of the information content, (See Paragraph 0026-0029).

9. As per claim(s) 4 Ferber teaches the claimed invention as described in claim(s) 1-3 above and furthermore discloses the information network comprises the Internet, (See Paragraph 0022).

10. As per claim(s) 5 Ferber teaches the claimed invention as described in claim(s) 1-4 above and furthermore discloses transferring the information content is enabled over a wireless communication channel, (See Paragraph 0021).

11. As per claim(s) 7 Ferber teaches the claimed invention as described in claim(s) 1-6 above and furthermore discloses the storage medium is provided to the individual when entering a means of transportation (i.e., wireless device), (See Paragraph 0023).

12. As per claim(s) 8 Ferber teaches the claimed invention as described in claim(s) 1-7 above and furthermore discloses identifying the individual; upon identification, enabling the individual to select the information content from a plurality of information contents; and, downloading the selected information content onto the mobile storage medium, (See Paragraph 0026-0029).

13. As per claim(s) 9 Ferber teaches the claimed invention as described in claim(s) 1-8 above and furthermore discloses enabling the individual enter identification information; selecting the information

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content based on the identification information; and, downloading the information content, (See Paragraph 0026-0029).

14. As per claim(s) 10 Ferber teaches the claimed invention as described in claim(s) 1-9 above and furthermore discloses the information content is selected based on a profile of the individual, (See Paragraph 0010).

15. As per claim(s) 11 Ferber teaches the claimed invention as described in claim(s) 1-10 above and furthermore discloses charging a fee for transferring the information content, (See Paragraph 0008).

16. As per claim(s) 14 Ferber discloses a connecting unit to access over the information network a repository hosting an information content; a receiving part for receiving a removable storage medium; and a transfer unit, coupled to the connecting unit and the receiving part, enabling to transfer the information content from the repository to the removable storage medium, (See Paragraph 0009-0011).

17. As per claim(s) 15 Ferber teaches the claimed invention as described in claim(s) 14 above and furthermore discloses the information network comprises the Internet, (See Paragraph 0022).

18. As per claim(s) 16 Ferber teaches the claimed invention as described in claim(s) 14-15 above and furthermore discloses the transfer unit allows storing the information content as digital data onto the removable storage medium, the storage medium comprising an optical storage medium, (See Paragraph 0022).

19. As per claim(s) 17 Ferber teaches the claimed invention as described in claim(s) 14-16 above and furthermore discloses the apparatus enables an individual to retrieve the storage medium; wherein the storage medium holds the data (i.e., coupons) for the user to retrieve and use, (See Paragraph 0030).

20. As per claim(s) 18 Ferber discloses a storage medium with pre-stored electronic information content selected on the basis of a profile of an individual and for use with an apparatus on board a means

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of transportation; wherein a means of transportation is interpreted as having unrestricted means to move anywhere wherein any definite object used to transport a device object or person can be but is not limited to a bicycle, a car, boat, or airplane, and even a persons own two feet, to enable the individual access to the information content, (See Paragraph 0026-0029).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- a. Determining the scope and contents of the prior art.
- b. Ascertaining the differences between the prior art and the claims at issue.
- c. Resolving the level of ordinary skill in the pertinent art.
- d. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 12 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber et al. (US Patent Application Publication No. 2002/0004746 and Ferber hereinafter) in view of Sporgis et al. (US Patent No. 6,320,495 and Sporgis hereinafter).

24. As per claims 12 Ferber discloses at a transit terminal, providing access over an information network to a repository hosting the information content; at the transit terminal, enabling to transfer the information content over the network between the repository and a mobile storage medium, (See Paragraph 0009-0011);

However, Ferber does not explicitly teach assigning a traveling location to the individual in a means of transportation, the means of transportation including the mobile storage medium; and,

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providing at the assigned traveling location an apparatus to enable the individual to access the information content.

Sporgis teaches assigning a traveling location to the individual in a means of transportation, the means of transportation including the mobile storage medium; and, providing at the assigned traveling location an apparatus to enable the individual to access the information content in the communication-restricted environment, (See Column 2 Lines 1-35).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Ferber with the teachings of Sporgis to include assigning a traveling location to the individual in a means of transportation, the means of transportation including the mobile storage medium; and, providing at the assigned traveling location an apparatus to enable the individual to access the information content with the motivation to provide for the navigational accuracy of GPS with the communications superiority of wireless technology to a game (i.e., any activity) of treasure hunt in order to create a challenging, enjoyable, and rewarding experience, (See Sporgis Column 1 Lines 55-61).

25. As per claim(s) 13 Ferber-Sporgis teaches the claimed invention as described in claim(s) 12 above and furthermore discloses the information content is determined from a plurality of information contents on the basis of a profile of the individual, (See Paragraph 0010).

26. As per claim(s) 6 Ferber-Sporgis teaches the claimed invention as described in claim(s) 1-5 above and furthermore discloses the storage medium is mass storage medium, (See Paragraph 0022). However, Ferber-Sporgis does not explicitly teach that the storage medium is an Optical storage medium. Examiner takes Official Notice (see MPEP § 2144.03) that use of optical storage devices in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re*

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Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Response to Arguments

27. Applicant's arguments filed September 3, 2004 have been fully considered but they are not persuasive. The applicants argued in substance that the prior art of record failed to teach the corresponding limitations of claims 6 and 7, specifically, an optical media and providing the storage medium upon entering a means of transportation. As to claim 6, the rejection has been modified to satisfy this claim element. As to claim 7, the prior art of record teaches implementing the system in mobile devices, such as automobile based PC's (See paragraph 0021).

The applicants did not argue in supports of any other limitations or claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

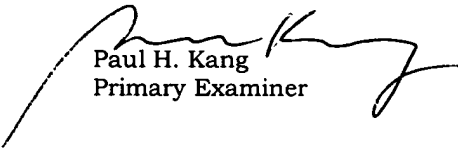
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul H. Kang
Primary Examiner